

REMARKS

This responds to the Office Action mailed on July 18, 2007.

Claims 1, 4-6, 11, 22, 29, and 31 are presently amended; claims 3, 13, and 14 are canceled; and no claims are added; as a result, claims 1-2, 4-12, and 15-33 are now pending and subject to examination in this application.

§112 Rejection of the Claims

Claims 1-33 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. The Applicant respectfully traverses this rejection.

The Office Action concedes that the Applicant's disclosure discusses that an invention can be evaluated based on its patentability, its legal aspects, its commercial viability, and its technical aspects. Nevertheless, the Office Action contends that the specification does not enable one of skill in the art to make or use the invention. The Applicant respectfully disagrees.

The Applicant respectfully submits that any particular method or means of evaluating an invention is not part of the inventive aspect of the presently claimed subject matter. Notwithstanding, a person of skill in the art would be able to perform, without undue experimentation, such an evaluation. Indeed, the specification states that automated tools are available to analyze and generate an evaluation of the worth of a patent,¹ that such evaluations can be done by qualified evaluators (further indicating that such evaluation techniques are known in the art),² and that a facilitator is a person who is experienced at processing and evaluating inventions.³ Additionally, the specification provides examples of aspects of an evaluation of patentability (prior art search), technical feasibility, commercial viability, and a legal evaluation of an invention.⁴ The Applicant further notes, in connection with the enabling disclosure of the pending application, that a patent specification is not intended nor required to be a production specification.⁵

¹ Application, p. 1, lines 22-26.

² *Id.*, p. 3, line 15.

³ *Id.*, p. 13, lines 20-21.

⁴ *Id.*, p. 12, lines 15-30.

⁵ *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1985); MPEP § 608.01(h).

Consequently, the Applicant respectfully submits that the rejection of the claims under § 112, 1st ¶ is in error, and respectfully requests the withdrawal of the rejection.

§103 Rejection of the Claims

Claims 1-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 20020032659 A1 to Waters, System and Method for Obtaining and Developing Technology for Market; in view of US Patent No. 6,298,327 Hunter et al., Expert Support System for Authoring Invention Disclosures.

The Applicant has amended the claims to recite a feature for controlling interaction between innovators and potential customers. This control feature includes providing anonymity of at least one of an innovator and a potential customer.

In rejecting claim 14, which recites providing anonymity of at least one of an innovator and a potential customer, the Office Action contended that ¶ 17 of Waters teaches anonymity between users. The Applicant respectfully disagrees. Paragraph 17 of Waters relates to maintaining confidentiality of property rights. Confidentiality is not anonymity, and anonymity is not confidentiality. For example, two people who know the identification of each other, can surely agree to keep an invention in confidence. In contrast, two people, at least one of whom is unaware of the identity of the other, can surely disclose an invention to another party (absent a confidentiality agreement). Consequently, the Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness vis-à-vis the anonymity feature, and respectfully requests the allowance of claims 1-33.

Claims 8, 21, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 20020032659 A1 to Waters, System and Method for Obtaining and Developing Technology for Market; in view of US Patent No. 6,298,327 Hunter et al., Expert Support System for Authoring Invention Disclosures.

Claims 8, 21, and 28 recite translating descriptions of inventions into desired languages. Without citing a prior art reference, the Office Action states that it would have been obvious to combine a translation feature with Waters so as to not limit the type

or nationality of customers who may be interested in funding an invention. The Applicant respectfully submits that a proper *prima facie* case of obviousness has not been established, at least because the Office Action has failed to cite a reference that discloses the feature of translating an invention description. Moreover, the Office Action provides as a rationale for this rejection that if a translation feature is present, the nationality or type of customers that are available to fund an invention will not be limited. However, securing funding of an invention is not even a recited feature in the independent claims. Rather, it only appears in dependent claims 4, 15, and 24. As such, the rationale is improper, and for this additional reason a *prima facie* case of obviousness has not been established.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2140 to facilitate prosecution of this application.

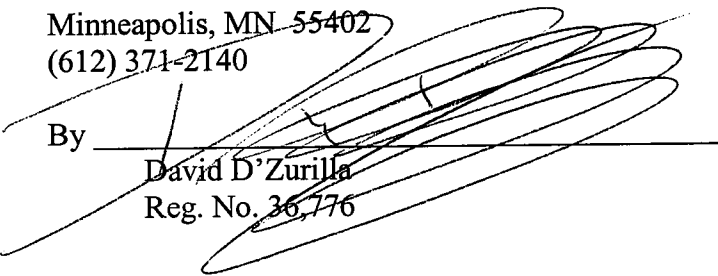
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date: January 18, 2008

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18TH day of January 2008.

PATRICIA A. HULTMAN

Name


Signature